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PTO/SB/33 (07-05)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

30101.188

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on 18 Dec 2006Signature [Signature]Typed or printed name Cliff D. Weston

Application Number

10/521.829

Filed

21 JAN 2005

First Named Inventor

PAYNE, Stephen A.

Art Unit

1751

Examiner

KHAN, Amina S.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal. (9)The review is requested for the reason(s) stated on the attached sheet(s). (9)

Note: No more than five (5) pages may be provided.

(3 pages)
(and Return Postcard)

I am the

☐ applicant/inventor.☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)☒ attorney or agent of record.
Registration number 48,307☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Signature

Cliff D. Weston

Typed or printed name

704-875-0806

Telephone number

18 Dec 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re: PAYNE, Stephen A. Examiner: KHAN, Amina S.
Serial No.: 10/521,829 Art Unit: 1751
Filed: August 1, 2005
For: DURABLE ANTIMICROBIAL LEATHER

ARGUMENT ACCOMPANYING PRE-APPEAL BRIEF REQUEST FOR REVIEW

Further to the Pre-Appeal Brief Request For Review, Applicant submits the following remarks regarding the rejections.

Claims 23-28, 31-35 and 37-68 currently are pending.

A. Rejection of Claims 23-28, 31-35, 37-39, 41, 44-47, 50-53, 55, 58-65 and 68 Under 35 U.S.C. § 103(a). Claims 23-28, 31-35, 37-39, 41, 44-47, 50-53, 55, 58-65 and 68 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pillay, U.S. Pat. No. 6,110,950 in view of Austin, U.S. Pat. No. 6,529,810.

Pillay '950 discloses a synergistic antimicrobial agent combination. (Pillay '950, *passim*.) The Examiner admits that Pillay '950, on its own, fails to teach or fairly suggest the antimicrobial composition recited in the present claims.

One of ordinary skill in the art would not be led by Pillay '950 to separate components of a synergistic combination, as doing so would destroy the very synergy discovered in the combination. In fact, Applicant respectfully asserts that the ordinary skilled artisan would in fact be taught away from separating a synergistic combination in order to engage in "mixing-and-matching" individual components of the synergistic combination disclosed therein with extraneous compounds. See *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959); accord MPEP 2143.01(VI) ("If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious."). The asserted combination of references therefore fails to establish a *prima facie* case of obviousness.

Pillay '810 and Austin '950 form the basis of the grounds for all rejections.

Austin '810 fails to provide the missing suggestion and is asserted in a way that changes the principle of operation of its invention. One of ordinary skill would not interpret Austin '810 as suggesting the destruction of Pillay's synergistic combination, as Austin '810 provides no reassurance that substitutions to the combination of Pillay '950 will retain the synergy. The Examiner asserts that one would substitute the polyhexamethylene biguanide of Austin '810 for the mercaptobenzothiazole of Pillay '950 because of the "functional equivalence of these compounds." Pillay '950 does not disclose a generic combination, but a synergistic combination

comprising interdependent chemical components. A substitution would be suggested to one-half of the synergistic Pillay '950 combination only if it likewise would produce a synergistic result; Austin '810 lacks this suggestion. Functional equivalence provides no expectation of synergy, whereas chemical structure and properties do. To this end, Applicant notes that polyhexamethylene biguanide and mercaptobenzothiazole have markedly different chemical properties and would not be seen by the ordinarily skilled artisan as chemically equivalent.

Austin '810 further teaches that its "compound of the general formula I" is a required element of its antimicrobial leather treatment composition. (See Austin '810, column 5, lines 16-20.) Relevant to polyhexamethylene biguanide (hereinafter "PHMB") as recited in the rejected claims, only Austin '810 mentions PHMB or any biguanide compound. Austin '810 teaches that PHMB may be optionally used *together with the antimicrobial composition of General Formula I*. (Austin '810, col 5, line 37 to col. 6, line 36.) The reference in no way teaches or fairly suggests that PHMB can be used on its own in effectively treating leather to confer an antimicrobial property thereto. Austin '810 likewise fails to teach or suggest that individual components of General Formula I can be separated out from General Formula I and used with PHMB. To do so would be to improperly dissect the essential invention of Austin '810—the antimicrobial composition of General Formula I. As used by the Examiner, the very of Austin '810—the compound of general formula I—would be excised and replaced with a compound from Pillay '950. The way in which Austin '810 is used in the rejection would improperly destroy the essence of its invention.

For these reasons, Austin '810 fails to assist Pillay '950 in forming a *prima facie* case of obviousness.

B. Rejection of Claims 42-43, 48, 56-57 and 66-67 Under 35 U.S.C. § 103(a).

Claims 42-43, 48, 56-57 and 66-67 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pillay, U.S. Pat. No. 6,110,950 in view of Austin, U.S. Pat. No. 6,529,810 (as applied above) and further in view of Rother, U.S. Pat. No. 5,888,415.

Rother '415 fails to provide the missing suggestion. Rother '415 teaches a microbicidal composition. The reference likewise fails to teach or suggest a substitution of one of its components for one-half of a synergistic combination (that of Pillay '950). Such substitution would destroy the synergy of the Pillay '950 combination; one of ordinary skill would be taught away from such substitution absent a showing in Rother '415 that the newly-formed antimicrobial composition would be at least as effective. Rother '415 lacks any suggestion and does not overcome the teaching-away of Pillay '950. Rother '415 likewise fails to assist in presenting a *prima facie* case of obviousness.

C. Rejection of Claims 40 and 54 Under 35 U.S.C. § 103(a). Claims 40 and 54 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Pillay, U.S. Pat. No. 6,110,950 in view of Austin, U.S. Pat. No. 6,529,810 (as applied above) and further in view of Lindner, U.S. Pat. No. 6,228,382.

Lindner '382 fails to provide the missing suggestion. Lindner '382 teaches a microbicidal composition. The reference likewise fails to teach or suggest a substitution of one of its components for one-half of a synergistic combination (that of Pillay '950). Such substitution would destroy the synergy of the Pillay '950 combination; one of ordinary skill would be taught away from such substitution absent a showing in Lindner '382 that the newly-formed antimicrobial composition would be at least as effective. Lindner '382 lacks any suggestion and does not overcome the teaching-away of Pillay '950. Alone or in combination with the other cited art, Lindner '382 fails to establish a *prima facie* case of obviousness.

D. Rejection of Claim 49 Under 35 U.S.C. § 103(a). Claim 49 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Pillay, U.S. Pat. No. 6,110,950 in view of Austin, U.S. Pat. No. 6,529,810 (as applied above) and further in view of Bryant, U.S. Pat. No. 5,087,457.

Bryant '457 fails to provide the missing suggestion and is asserted in a way that changes the principle of operation of its invention. One of ordinary skill likewise would not interpret Bryant '457 as suggesting the destruction of Pillay's synergistic combination, as Bryant '457 provides no reasonable expectation that substitutions to the combination of Pillay '950 will successfully retain the synergy of either reference.

And again, Bryant '457 itself teaches a synergistic combination of chemicals. To break the synergistic combinations of both Bryant '457 and Pillay '950 in order to mix-and-match individual components from each would destroy the synergies of each and impermissibly "change the principle of operation of the prior art invention[s] being modified".

For these reasons, Bryant '415 fails to establish a *prima facie* case of obviousness.

CONCLUSION

The claims as currently pending are allowable over the art of record. Applicant respectfully requests that the rejections be withdrawn and the application be advanced to allowance.

Respectfully submitted,



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